



APR 09 2002

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In re Application of	:	
KELLY et al.	:	
U.S. Application No. 09/787,602	:	DECISION ON PETITION
PCT No.: PCT/US99/21666	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 20 September 1999	:	
Priority Date: 21 September 1998	:	
Attorney Docket No.: MOT-D2191	:	
For: METHOD AND APPARATUS FOR	:	
SHUFFLING AND DESHUFFLING	:	
VIDEO SIGNALS	:	

This decision is in response to the "RENEWED PETITION UNDER 37 CFR 1.47(a)" filed 08 February 2002. In a decision dated 27 November 2001, the "RENEWED PETITION UNDER 37 CFR 1.47(a)" filed 27 August 2001 was dismissed because applicant did not provide adequate proof that the joint inventor, Charles P. Kelly, refused to execute the application or could not be reached after diligent effort.

### DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the nonsigning joint inventor. The 27 November 2001 decision indicated that petitioner satisfied items (1), (3) and (4) above.

As to item (2), petitioner states that Charles P. Kelly has refused to sign the application papers. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning

inventor is represented by counsel, to the address of the nonsigning inventor's attorney . . . It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

A review of the present petition and the accompanying papers reveal that applicant has not satisfied item (2) above, in that the applicants have not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Charles P. Kelly. Petitioner states that a complete application was sent to Mr. Kelly via FedEx on December 18, 2001 and further that "FedEx attempted redeliver the package to Mr. Kelly at which point a waiver had been signed by someone at Mr. Kelly's address granting FedEx permission to leave the package if no one was home. It appears that the individual that signed the waiver for the package did not want to cooperate and signed the waiver with the name of the undersigned's secretary, Amy McShea, whose name was on the mailing label." This is incorrect as indicated on the attached FedEx printouts, the shipper released FedEx from obtaining a signature of the recipient and no such signature was obtained. Thus, it is unclear whether Mr. Kelly in fact resides at the address to which the complete application was sent and therefore, whether he was presented with

the application papers required when refusal is alleged.

Additionally, petitioner states that Charles P. Kelly cannot be found or reached after diligent effort. However, the present petition does not set forth facts showing that a diligent effort was made to locate or reach the non-signing inventor. See MPEP 409.03(d) for further information as to what constitutes diligent effort.

For the reasons stated above, it would not be appropriate to accept the application without the signature of Charles P. Kelly under 37 CFR 1.47(a) at this time.

### CONCLUSION

The renewed petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention to the PCT Legal Office.



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